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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 09/370,601   | 08/10/1999  | KRISTINE B. FUIMAONO | 34063/KMO/W1           | 8267             |
| 23363  | 7590        | 04/13/2004           | EXAMINER               |                  |
| CHRISTIE, PARKER & HALE, LLP<br>350 WEST COLORADO BOULEVARD<br>SUITE 500<br>PASADENA, CA 91105 |             |                      | RODRIGUEZ, CRIS LOIREN |                  |
|  |             |                      | ART UNIT               | PAPER NUMBER     |
|  |             |                      | 3763                   | 33               |
| DATE MAILED: 04/13/2004  |             |                      |                        |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                       |
|------------------------------|-----------------|-----------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)          |
|                              | 09/370,601      | FUIMAONO, KRISTINE B. |
| Examiner                     | Art Unit        |                       |
| Cris L. Rodriguez            | 3763            |                       |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 2/9/04, 1/2/04.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 2-49, 51, 52 and 54-63 is/are pending in the application.
  - 4a) Of the above claim(s) 24-39 and 41-47 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-16, 18-23, 48, 49, 51, 52, 54-63 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-4, 6, 7, 12, 14-16, 18, 48, 49, 51, 52, and 54-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Desai (US 6,231,591).

Desai discloses an endoscopic surgical instrument assembly (figs. 25-36B) for tissue ablation having

- a probe body 309 with an ablation electrode 306, extending the length of the electrode probe body, and made of nickel-titanium or other resilient or conductive material (col. 18 lines 18-21) with at least one opening,
- means for introducing fluid into the inner cavity comprising an infusion tube 378 attached to the proximal end of the ablation electrode by means of adaptor 374 and sliding portion 338 (col. 19 lines 4-11),
- a sheath 354 or 344 positioned on the elongated ablation electrode defining an exposed distal portion at 306 (figs. 25-26),
- and a handle at 320,338. The probe body is generally rigid from its proximal to its distal end. The ablation electrode is generally straight and forms an angle with the remainder of the probe body.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai.

Desai discloses the invention substantially as claimed. However, Desai fails to disclose the tubular electrode being made of stainless steel, and the length and the diameters of the electrode and probe body as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select stainless steel for the electrode as an obvious design choice, since the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Furthermore, the instant disclosure describes the length and diameters dimensions as being merely preferable, and does not describe it as contributing any unexpected result to the probe. As such, these parameters are deemed matters of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results.

5. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai in view of Ashley (6,176,857).

Desai discloses the invention substantially as claimed as discussed above. However, Desai fails to disclose the tubular electrode being malleable.

Ashley teaches a surgical instrument, (fig 4A-6A), where the tip and tubular shaft probe 404 (electrode) is made of the same tubing (such as a metal conducting shaft), and the shaft can be a malleable stainless steel (col. 8 lines 40-59). Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Ashley's malleable stainless steel material into Desai's needle electrode. Doing so would have improved the needle/electrode conformation, particular for the patient's body, to access the location to be treated.

***Response to Arguments***

6. Applicant's arguments filed January 2, 2004 and February 9, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that Desai fails to disclose an elongated electrode that extends the length of the probe body and has a proximal end that is received in the handle housing. The Examiner disagree and direct applicants attention to figures 25-36B, but specifically figure 27 where it is clearly shown these features in reference numeral 306. Figures 25, and 36A-36B also shows that the electrode distal tip portions 306,402 and 480 are fully exposed upon movement of a sliding portion 338.

In response to applicant's arguments that Ashley does not disclose structures beyond the tips and the shafts, and an elongated ablation electrode extending the length of an elongated probe body or having a proximal end that is received in a handle housing as set forth in claims 2 and 6. These elements are shown in Desai as described in the rejection above. Ashley shows that is well known in the art the use of

malleable elongated tubular electrodes for applying heat. Therefore, the combination of Desai and Ashley would have been obvious.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 6, 2004

  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

  
LOAN H. THANH  
PRIMARY EXAMINER